

Question Q217

National Group: **Italy**

Title: **The patentability criterion of inventive step / non-obviousness**

Reporter within Working Committee: Lamberto Liuzzo

Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?

According to Italian case law, the evaluation of inventive step is based on the concept of “non evident from the prior art” for a person skilled in the art. According to this definition an absolute level of inventiveness is not required. It is not important whether the level of technical improvement is either high or low. However, there is no exact definition in place for this standard. In our jurisdiction the judges are normally assisted by court appointed technical experts to render their decisions.

2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?

The standard has indeed evolved during the past 20 years. In relation to technical/industrial evolution within our jurisdiction, the standard has not undergone significant change. We do not see a correlation between technical/industrial evolution and the standard of inventive step.

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?

Currently there are no examination guidelines.

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?

A substantive examination on the merits regarding inventive step is carried out only during judicial proceedings. Since examination on the merits during grant proceedings was introduced in Italy only recently and is not operative yet, it is not possible to define at this stage a reliable standard for the inventive step during the examination proceedings.

Construction of claims and interpretation of prior art

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?

The claims define the scope of protection and are construed as they would be understood by a person skilled in the art taking into account the description and drawings of the patent.

6. Is it possible to read embodiments from the body of the specification into the claims?

Provided they fall within the generic terms of the claims, it is possible to read embodiments from the body of the specification into those claims.

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?

The prior art is interpreted as would be understood by a person skilled in the art. Reliance on inherent disclosures is also permitted.

8. Do the answers to any of the questions above differ during examination versus during litigation?

See above (point 4).

Combination or modification of prior art

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?

It is proper in the Italian jurisdiction to find lack of inventive step over a single prior art reference. Common general knowledge is required to provide the missing teaching(s), and argument may be sufficient when based on common general knowledge. The level of common general knowledge is an issue to be considered.

10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?

Implicit motivation is at least required for a person skilled in the art to combine two or more prior art references.

11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?

When two or more prior art references are combined, the closeness of the technical field to what is being claimed is highly relevant. The problem the inventor of the claim in question is trying to solve is also highly relevant.

12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?

Yes, it is permitted in the Italian jurisdiction to combine more than two references to show lack of inventive step. The standard is not different from when only two references are combined.

13. Do the answers to any of the questions above differ during examination versus during litigation?

See above (point 4).

Technical Problem

14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?

The technical problem to be solved plays an essential role in determining inventive step.

15. To what degree, if any, must the technical problem be disclosed or identified in the specification?

The technical problem must be sufficiently defined to allow the judge to evaluate the inventive step.

Advantageous effects

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

Advantageous effects play an important role in determining inventive step, in particular if they are unexpected in quality or degree.

17. Must the advantageous effects be disclosed in the as-filed specification?

The advantageous effects need not be disclosed in the specification but nevertheless should be connected with and derivable from the technical effect proposed in the patent application.

18. Is it possible to have later-submitted data considered by the Examiner?

It is generally accepted to have later-submitted data considered by the Judge.

19. How “real” must the advantageous effects be? Are paper or hypothetical examples sufficient?

Advantageous effects must be considered “real”; paper and hypothetical examples may be sufficient provided they are workable and can be credibly interpreted based on the state of the art.

20. Do the answers to any of the questions above differ during examination versus during litigation?

See above (point 4).

Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favor of inventive step / non-obviousness? Must the teaching be explicit?

The Italian jurisdiction recognizes teaching away as a factor in favour of inventive step and it need not be explicit.

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

Teaching away may be considered one of the primary indicia of inventive step.

23. Is there any difference in how teaching away is applied during examination versus in litigation?

See above (point 4).

Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?

Yes, secondary considerations are recognized in the Italian jurisdiction.

25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the *claimed* invention and the secondary considerations required?

- a) In the Italian jurisdiction, the most relevant accepted secondary considerations include: the commercial success of the claimed invention; copying or licensing to third parties; failure of others to solve the problem; unexpected or surprising technical progress/advantage; whether a patent provides an answer for long-term needs, etc.
- b) Accepted secondary considerations must be proven to the same degree as other facts relevant to the patent claims.
- c) It is often important to show that secondary considerations are intimately tied to the claimed invention and are not a result of unrelated factors or market forces.

26. Do the answers to any of the questions above differ during examination versus during litigation?

See above (point 4).

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?
If yes, please describe these issues, tests, or factors.

No, there are no other issues taken into consideration.

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and, if so, provide a brief summary of such interpretation.

There is no specific statement of the test for inventive step in the Italian jurisdiction. Judges rely on the terms contained within the law stating that “an invention shall be considered to involve an inventive step if, having regard to the state of the art, it is not evident for a person skilled in the art”.

29. Does such test differ during examination versus during litigation?

See above (point 4).

Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

In view of point 4, it is currently not yet possible to define whether there is a divergence between the attitude taken by the courts and the patent granting authority during examination.

31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

In view of the current situation mentioned above, this question cannot be answered.

Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?

Italy has two patent granting authorities (its national authority, and the European authority). There is however no way to confirm whether they diverge in their approach to inventive step as a result of what has been stated previously at point 4.

33. If yes, is this problematic?

See above (point 32).

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

34. Is harmonization of inventive step / non-obviousness desirable?

Yes, harmonization is desirable.

35. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?

It would be advisable to find a universally acceptable standard for inventive step, however differences in countries' legal systems and cultural backgrounds might represent a significant obstacle in doing so.

36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.

The Italian group favours the EPC definition of inventive step, corresponding to the definition contained in the Italian IP code, specifically: "an invention shall be considered to involve an inventive step if, having regard to the state of the art, it is not evident for a person skilled in the art".

37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.

The Italian group supports the approach outlined in the EPO's established case law based on the problem/solution approach.

Summary

According to Italian case law, the evaluation of inventive step is based on the concept of non evident from the prior art for a person skilled in the art. However, there is no exact definition in place for this standard. Judges are normally assisted by court appointed technical experts to render their decisions. A substantive examination on the merits regarding inventive step is carried out only during judicial proceedings. In evaluating inventive step the claims are construed as they would be understood by a person skilled in the art taking into account the description and drawings of the patent. It is proper in the Italian jurisdiction to find lack of inventive step over a single prior art reference. It is also permitted to combine more than two references to show lack of inventive step. When relied upon, the level of common general knowledge is an issue to be considered. The technical problem to be solved plays an essential role in determining inventive step. Advantageous effects/teaching away play an important role in determining inventive step. Secondary indicia are recognized in the Italian jurisdiction. There is no specific statement of the test for inventive step in the Italian jurisdiction. Judges rely on the terms contained within the law. As a proposal for harmonisation, the Italian group supports the EPC definition of inventive step and the approach outlined in the EPO's established case law based on the problem-solution approach.